

Application No. 09/518,756
Response to Paper No. 12
Page 2 of 14

Rejection Under 35 U.S.C. § 102(b).

Claims 9-37 and 39 stand rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by *Seymour et al.* (US 4,923,454). Applicants submit that claims 9-37 and 39 are not anticipated by *Seymour et al.*

Seymour et al. describes absorbent web structures suitable for incorporation into absorbent articles such as sanitary napkins, diapers, incontinent devices, training pants and the like. Such structures are described as comprising webs of entangled melt blown microfibers which are prepared from a particular type of hydrophilic nylon copolymer. Preferred hydrophilic nylon microfiber-based webs also contain staple fibers and/or particles of hydrogel-forming polymeric gelling agent. Web structures containing hydrophilic nylon microfibers are described as having desirable comfort, integrity and fluid handling characteristics.

With respect to independent claims 9 and 35 of the Application, Applicants submit that the subject matter claimed therein patentably distinguishes over *Seymour et al.* Specifically, claims 9 and 35 claim absorbent articles incorporating specific materials having specific properties and arranged in specific constructions. *Seymour et al.* neither shows nor suggests absorbent articles incorporating these specific materials having these specific properties and arranged in these specific constructions. As stated by the Court of Appeals for the Federal Circuit,

Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, *arranged as in the claim.*¹

This, the Examiner has not done. Thus, Applicants submit that independent claims 9 and 35 each patentably distinguish over *Seymour et al.* With regard to dependent claims 10-34, 36, 37 and 39 it is axiomatic that a dependent claim must be read as including the claim from which it depends. Consequently, the Examiner's rejection, under 35 U.S.C. § 102(b), is improper and should be withdrawn.

¹ *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1458, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983)) (emphasis added).

Application No. 09/518,756
Response to Paper No. 12
Page 3 of 14

Applicants cannot leave their discussion of 35 U.S.C. § 102(b) without discussing *Ex parte Slob*, 157 USPQ 172 (Pat. & Tr. Office Bd. App. 1968), as relied on by the Examiner. In this regard, the Examiner asserts that

the limitation of having a Liquid Wicking Value of at least about 38% in one of the first and second primary layer regions fails to provide patentable distinction over the prior art. The prior art is found to disclose each chemical and structural feature instantly claimed, therefore it must meet the property requirement specified, otherwise, applicant's claim is incomplete. Note *ex parte Slob* (157 USPQ 172), which supports this conclusion. The same applies to the claimed MAUL and Tau values.

However, a close reading of *Ex parte Slob* indicates that the claims therein were rejected under 35 U.S.C. § 112. Consequently, *Ex parte Slob* is inapposite with regard to the 35 U.S.C. § 102(b) rejection put forth by the Examiner.

Rejections Under 35 U.S.C. § 103.

To reach a proper determination of *prima facie* obviousness under 35 U.S.C. § 103, the Examiner must step backward in time and into the shoes worn by the hypothetical person of ordinary skill in the art when the invention was unknown and just before it was made. *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1566, 1 USPQ2d 1593, 1595-96 (Fed. Cir. 1987). In view of all factual information, the Examiner must then make a determination whether the claimed invention "as a whole" would have been obvious at that time to that person. *Id.* Knowledge of applicants' specification must be put aside in reaching this determination, yet kept in mind in order to determine the "differences," conduct the search and evaluate the "subject matter as a whole" of the invention. The tendency to resort to "hindsight" based upon applicants' specification is often difficult to avoid due to the very nature of the examination process. However, impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.

To establish a *prima facie* case of obviousness, three basic criteria must be met.² First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to

² MPEP § 2143.

Application No. 09/518,756
Response to Paper No. 12
Page 4 of 14

combine reference teachings.³ Second, there must be a reasonable expectation of success.⁴ Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.⁵ The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicants' specification.⁶

For any or all of the reasons advanced below, the Examiner has in this instance again failed to establish a *prima facie* case of obviousness, and thus has not shifted to Applicants the burden of going forward.

Seymour et al. in view of Dodge, II et al.

Claims 1, 4, 6-8 and 40-42 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over *Seymour et al.* (US 4,923,454) as applied to claims 9-37 and 39 above, and further in view of *Dodge, II et al.* (US 5,820,973). This rejection is traversed as the Examiner again fails to present a *prima facie* case of obviousness.

According to the Examiner, *Seymour et al.* discloses a virtual laundry list of elements that may also be found in Applicants' claimed invention. The Examiner admits, however, that *Seymour et al.* fails to expressly disclose that the absorbent core has a crotch width of not more than about 10 cm. To remedy this and other defects in *Seymour et al.*, the Examiner cites *Dodge, II et al.* for disclosing a design of an absorbent article with a narrow crotch. The Examiner alleges that it

would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the absorbent article and provide it with a narrow crotch to reduce the bulkiness in the crotch region of the article, improve the fit, comfort and aesthetics.

Based on at least any or all of the following remarks, the Examiner has not established a *prima facie* case of obviousness for the present claims over *Seymour et al.* in view of *Dodge, II et al.*

³ *Id.*

⁴ *Id.*

⁵ *Id.*

⁶ *Id.*

Application No. 09/518,756
Response to Paper No. 12
Page 5 of 14

There must be a teaching, suggestion or motivation to combine.

A teaching, suggestion or motivation to combine is an essential evidentiary component of an obviousness holding. *C.R. Bard, Inc. v. M3 Sys., Inc.*, 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed Cir. 1998). Evidence of a suggestion, teaching or motivation to combine may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved, *see, Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc.*, 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1630 (Fed. Cir. 1996), although “the suggestion more often comes from the teachings of the pertinent references,” *In re Rouffet*, 149 F.3d 1350, 1355, 47 USPQ2d 1453, 1456 (Fed. Cir. 1998). The range of sources available, however, does not diminish the requirement for actual evidence. That is, the showing must be clear and particular. *See, e.g., C.R. Bard*, 157 F.3d at 1352, 48 USPQ2d at 1232. Broad conclusory statements regarding the teaching of multiple references, standing alone, are not “evidence.” *E.g., McElmurry v. Arkansas Power & Light Co.*, 995 F.2d 1576, 1578, 27 USPQ2d 1129, 1131 (Fed. Cir. 1993) (“Mere denials and conclusory statements, however, are not sufficient to establish a genuine issue of material fact.”). In addition to demonstrating the propriety of an obviousness analysis, particular factual findings regarding the suggestion, teaching or motivation to combine serve a number of important purposes, including: (1) clear explication of the position adopted by the Examiner; (2) identification of the factual disputes, if any, between the applicants and the Examiner; and (3) facilitation of review of appeal. *In re Dembiczak*, 175 F.3d 994, 1000, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). Here, however, the Examiner has not made particular findings regarding the locus of the suggestion, teaching or motivation to combine the cited references.

The obviousness rejection of the Examiner results from a combination of *Seymour et al.* in view of *Dodge, II et al.* To justify this combination, the Examiner simply states that it would have been obvious to combine the cited references. Nowhere does the Examiner particularly identify any suggestion, teaching or motivation to combine the secondary reference with the primary reference, nor does the Examiner make specific – or even inferential – findings concerning the identification of the relevant art, the level of ordinary skill in the art, the nature of the problem to be solved, or any other factual findings that might serve to support a proper obviousness analysis. *See, e.g., Pro-Mold & Tool Co.*, 75 F.3d at 1573, 37 USPQ2d at 1630.

Application No. 09/518,756
Response to Paper No. 12
Page 6 of 14

To the contrary, the obviousness analysis conducted by the Examiner is limited to a discussion that it would have been obvious to combine the cited references to read on the claimed invention. For example, the Examiner admits that *Seymour et al.* fails to expressly disclose that the absorbent core has a crotch width of not more than about 10 cm, finds that *Dodge, II et al.* teaches the use of a design of an absorbent article with a narrow crotch, and then baldly concludes that it would have been obvious to modify the absorbent article and provide it with a narrow crotch. Yet this reference-by-reference, limitation-by-limitation analysis fails to demonstrate how the secondary reference teaches or suggests its combination with the primary reference.⁷ In this instance, the Examiner fails to show, with any degree of clarity or particularity, that the cited references teach, suggest or motivate the combination advocated. As a teaching, suggestion or motivation to combine is an essential evidentiary component of an obviousness holding, the Examiner has not established a *prima facie* case of obviousness, and thus has not shifted to Applicants the burden of going forward.

References must suggest the desirability of making the combination.

While non-obviousness cannot be established by attacking references individually where the rejection is based upon the teachings of a combination of references, *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981), and *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986), the critical inquiry is whether there is something in the references as a whole to suggest the desirability, and thus the obviousness, of making the combination, *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1462, 221 USPQ 481, 488 (Fed. Cir. 1984).

In this instance, there is no such suggestion. As admitted by the Examiner, *Seymour et al.* fails to disclose an absorbent core having a crotch width of less than about 10 cm. To remedy this and other defects in *Seymour et al.*, the Examiner cites *Dodge, II et al.* as disclosing an absorbent article having a narrow crotch. The Examiner alleges that it would have been obvious to substitute the narrow crotch of *Dodge, II et al.* into the absorbent article of *Seymour et al.* to reduce the bulkiness in the crotch region of the absorbent article. Contrary to the Examiner's

⁷ See, *In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed Cir. 2000) ("[A] rejection cannot be predicated on the mere identification ... of individual components of claimed limitations. Rather, particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed.").

Application No. 09/518,756
Response to Paper No. 12
Page 7 of 14

allegations, however, *Dodge, II et al.* does not, simply by virtue of merely mentioning the use of a design of an absorbent article with a narrow crotch, suggest that which the Examiner states is obvious.⁸ As discussed herein, the cited references as a whole provide no suggestion to the desirability, and thus the obviousness, of making the combination advocated by the Examiner. Consequently, the Examiner has not established a *prima facie* case of obviousness, and thus has not shifted to Applicants the burden of going forward.

Motivation to combine cannot derive from Applicants' specification.

The motivation to combine cannot derive from Applicants' specification. *See, In re Dow Chem. Co.*, 837 F.2d 469, 473, 5 USPQ2d 1529, 1531-32 (Fed. Cir. 1988) ("[t]here must be a reason or suggestion in the art for selecting the procedure used, other than the knowledge learned from the applicant's disclosure"). Measuring a claimed invention against the standard established by 35 U.S.C. § 103 requires the oft-difficult but critical step of casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. *In re Dembiczak*, 175 F.3d at 999, 50 USPQ2d at 1617. The Examiner cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention. *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988).

It is quite clear that the best defense against a hindsight-based obviousness analysis is the rigorous application of the requirement for a showing of a teaching or motivation to combine the prior art references. *See, Dembiczak*, 175 F.3d at 999, 50 USPQ2d at 1617. "Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability – the essence of hindsight." *Id.* In this instance, the Examiner has improperly used Applicants' disclosure as a blueprint with the absorbent article of *Seymour et al.* serving as the starting block and then looking to *Dodge, II et al.* for elements present in the disclosure, but missing from the absorbent article of *Seymour et al.* The Examiner does not discuss any specific evidence of motivation to combine, but only makes broad conclusory statements. "Broad conclusory statements regarding the teaching of multiple references, standing alone, are not 'evidence'." *Id.*

⁸ *See*, MPEP § 2143.01 ("The mere fact that references *can* be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).").

Application No. 09/518,756
Response to Paper No. 12
Page 8 of 14

In this instance, the Examiner fails to identify with sufficient specificity any such reason or suggestion regarding the motivation to combine the cited references in the manner advocated. Consequently, the use of Applicants' disclosure to reconstruct the claimed invention from isolated pieces of the cited references contravenes the statutory mandate of 35 U.S.C. § 103.

Bewick-Sonntag et al. in view of Zenker et al. and Dodge, II et al.

Claims 1, 4, 6-8 and 41-42 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over *Bewick-Sonntag et al.* (US 5,762,641) in view of *Zenker et al.* (US 6,245,051 B1) and *Dodge, II et al.* (US 5,820,973). This rejection is traversed as the Examiner again fails to present a *prima facie* case of obviousness.

According to the Examiner, *Bewick-Sonntag et al.* discloses an absorbent article having a number of elements that may also be found in Applicants' claimed invention. The Examiner admits, however, that *Bewick-Sonntag et al.* does not disclose an absorbent core having a dry thickness of less than about 6 mm and a minimum crotch width of less than about 10 cm. To remedy this and other defects in *Bewick-Sonntag et al.*, the Examiner cites *Zenker et al.* as disclosing an absorbent article having a retention portion that can have a dry thickness of between about 0.1 and 0.8 cm and *Dodge, II et al.* for disclosing a design of an absorbent article with a narrow crotch. The Examiner alleges that it

would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the absorbent article and provide it with a dry thickness between about 0.1 cm to about 0.8 cm, and with a narrow crotch for the purpose of reducing a wet-thickness of the absorbent structure and also to reduce the bulkiness in the crotch region of the article, improve the fit, comfort and aesthetics ...

Based on at least any or all of the following remarks, the Examiner has not established a *prima facie* case of obviousness for the present claims over *Bewick-Sonntag et al.* in view of *Zenker et al.* and *Dodge, II et al.*

There must be a teaching, suggestion or motivation to combine.

A teaching, suggestion or motivation to combine is an essential evidentiary component of an obviousness holding. *C.R. Bard, Inc. v. M3 Sys., Inc.*, 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed Cir. 1998). Evidence of a suggestion, teaching or motivation to combine may flow

Application No. 09/518,756
Response to Paper No. 12
Page 9 of 14

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The obviousness rejection of the Examiner results from a combination of *Bewick-Sonntag et al.* in view of *Zenker et al.* and *Dodge, II et al.* To justify this combination, the Examiner simply states that it would have been obvious to combine the cited references. Nowhere does the Examiner particularly identify any suggestion, teaching or motivation to combine the secondary references with the primary reference, nor does the Examiner make specific – or even inferential – findings concerning the identification of the relevant art, the level of ordinary skill in the art, the nature of the problem to be solved, or any other factual findings that might serve to support a proper obviousness analysis. *See, e.g., Pro-Mold & Tool Co.*, 75 F.3d at 1573, 37 USPQ2d at 1630.

To the contrary, the obviousness analysis conducted by the Examiner is limited to a discussion that it would have been obvious to combine the cited references to read on the claimed invention. For example, the Examiner admits that *Bewick-Sonntag et al.* does not disclose an absorbent core with a dry thickness of less than about 6 mm and a minimum crotch width of less

Application No. 09/518,756
Response to Paper No. 12
Page 10 of 14

than about 10 cm, finds that *Zenker et al.* teaches a retention portion that can have a dry thickness of between about 0.1 and 0.8 cm, finds that *Dodge, II et al.* teaches the use of a design of an absorbent article with a narrow crotch, and then baldly concludes that it would have been obvious to modify the absorbent article and provide it with a dry thickness of between about 0.1 and 0.8 cm and a narrow crotch. Yet this reference-by-reference, limitation-by-limitation analysis fails to demonstrate how the secondary references teach or suggest their combination with the primary reference.⁹ In this instance, the Examiner fails to show, with any degree of clarity or particularity, that the cited references teach, suggest or motivate the combination advocated. As a teaching, suggestion or motivation to combine is an essential evidentiary component of an obviousness holding, the Examiner has not established a *prima facie* case of obviousness, and thus has not shifted to Applicants the burden of going forward.

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In this instance, there is no such suggestion. As admitted by the Examiner, *Bewick-Sonntag et al.* does not disclose an absorbent core with a dry thickness of less than about 6 mm and a minimum crotch width of less than about 10 cm. To remedy this and other defects in *Bewick-Sonntag et al.*, the Examiner cites *Zenker et al.* as teaching a retention portion having a dry thickness of between about 0.1 and 0.8 cm and *Dodge, II et al.* as teaching the design of an absorbent article having a narrow crotch width. The Examiner alleges that it would have been obvious to incorporate the dry thickness of *Zenker et al.* and the narrow crotch of *Dodge, II et al.* into the absorbent article of *Bewick-Sonntag et al.* to reduce the bulkiness in the crotch region of

⁹ See, *In re Kozab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed Cir. 2000) (“[A] rejection cannot be predicated on the mere identification ... of individual components of claimed limitations. Rather, particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed.”).

Application No. 09/518,756
Response to Paper No. 12
Page 11 of 14

the absorbent article. Contrary to the Examiner's allegations, however, *Zenker et al.* does not, simply by virtue of merely mentioning that a retention portion can have a dry thickness of between about 0.1 and 0.8 cm, suggest that which the Examiner states is obvious.¹⁰ As discussed herein, the cited references as a whole provide no suggestion to the desirability, and thus the obviousness, of making the combination advocated by the Examiner. Consequently, the Examiner has not established a *prima facie* case of obviousness, and thus has not shifted to Applicants the burden of going forward.

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¹⁰ *See*, MPEP § 2143.01 ("The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).").

Application No. 09/518,756
Response to Paper No. 12
Page 12 of 14

statements. "Broad conclusory statements regarding the teaching of multiple references, standing alone, are not 'evidence'." *Id.* In this instance, the Examiner fails to identify with sufficient specificity any such reason or suggestion regarding the motivation to combine the cited references in the manner advocated. Consequently, the use of Applicants' disclosure to reconstruct the claimed invention from isolated pieces of the cited references contravenes the statutory mandate of 35 U.S.C. § 103.

Inherency.

The Examiner next asserts that as "for Claim 4, the Combined Conductance-Wicking Value is inherent from the structure in the independent claim." However, the Examiner's reliance on the doctrine of inherency to support an obviousness rejection is improper.¹¹ The doctrine of inherency generally is only available where a rejection is based on anticipation. In this instance, the Examiner is attempting to make an obviousness rejection under 35 U.S.C. § 103. Consequently, the Examiner's attempt to extend the doctrine of inherency to an obviousness rejection is improper and should be withdrawn.

Applicants cannot leave their discussion of 35 U.S.C. § 103 without discussing *Ex parte Slob*, 157 USPQ 172 (Pat. & Tr. Office Bd. App. 1968), as relied on by the Examiner. In this regard, the Examiner asserts that

the limitation of having a Liquid Wicking Value of at least about 38% in one of the first and second primary layer regions fails to provide patentable distinction over the prior art. The prior art is found to disclose each chemical and structural feature instantly claimed, therefore it must meet the property requirement specified, otherwise, applicant's claim is incomplete. Note *ex parte Slob* (157 USPQ 172), which supports this conclusion. The same applies to claims 7-8.

¹¹ See *In re Spormann*, 363 F.2d 444, 448 (C.C.P.A. 1966) ("the inherency of an advantage and its obviousness are entirely different questions."); *In re Shetty*, 566 F.2d 81, 86 (C.C.P.A. 1977); and *Jones v. Hardy*, 727 F.2d 1524, 1529 (Fed. Cir. 1984) (the conclusion that "the discovery of a use of an inherent quality of a product well known in the art is not patentable because of obviousness ... confuses anticipation by inherency, i.e., lack of novelty, with obviousness, which, though anticipation is the epitome of obviousness, are separate and distinct concepts.").

Application No. 09/518,756
Response to Paper No. 12
Page 13 of 14

However, a close reading of *Ex parte Slob* indicates that the claims therein were rejected under 35 U.S.C. § 112. Consequently, *Ex parte Slob* is inapposite with regard to the 35 U.S.C. § 103 rejection put forth by the Examiner.

Miscellaneous Arguments

It may also be argued that motivation for combining the teachings of a prior art reference may be based upon an Examiner's explanation founded on logic and sound scientific principle. However, when an Examiner relies on a scientific theory, evidentiary support for the existence and meaning of that theory must be provided.¹² In this instance, the Examiner has failed to introduce into the record evidentiary support for any such logic or sound scientific principle. In fact, it is unclear how one of ordinary skill in the art would be led to combine the teachings of the cited references.

Applicants urge that the only possible incentive to combine the teachings of the cited references improperly stems from the teachings of Applicants' specification. In view of there being no incentive to support combining the references relied upon, it appears that the Examiner has grounded her rejection on unestablished prior art. However, no fact or other information has been placed in the record that suggests or provides incentive for making Applicants' invention. Applicants have respectfully and timely traversed any assertion that the claimed invention is "common knowledge" or "well known" or that any fact not of record is "common knowledge" or "well known" since any such fact has neither been raised nor addressed by the Examiner. Should the Examiner persist, however, in basing her rejections on facts within her personal knowledge, Applicants hereby call for the Examiner to support any such facts by way of an affidavit in accordance with MPEP § 2144.03.¹³

CONCLUSION

For at least any or all of the foregoing remarks, the rejections of claims 1, 4, 6, 7, 9-37, and 39-42 of the Application are improper and should be withdrawn. Consequently, Applicants

¹² See, MPEP § 2144.02

¹³ "When a rejection is based on facts within the personal knowledge of the examiner, the data should be stated as specifically as possible, and the facts must be supported, when called for by the applicant, by an affidavit from the examiner."

Application No. 09/518,756
Response to Paper No. 12
Page 14 of 14

submit that the Application remains in condition for allowance and that action is earnestly solicited.


In the event the Examiner has any questions concerning this Response, the Examiner is invited to contact Applicants' Attorney at the telephone number listed below.

The Commissioner is hereby authorized to charge any fee(s) which may be required for this paper to Kimberly-Clark Worldwide, Inc., Deposit Account No. 11-0875.

Respectfully submitted,

R.D. EVERETT, et al.

Date: July 31, 2002



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